IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of

TRIFOREST ENTERPRISES INCORPORATED Opposer, v. NALGE NUNC INTERNATIONAL CORPORATION Applicant.	TTAB Opposition 91165809 Trademark application Serial No. 76/572,253 Published in the Official Gazette on (Date) 3/18/2005 For Plastic water bottle, sold empty, in IC 21

REPLY TO MOTION TO COMPEL

There are two reasons why the Board should deny applicant's motion to compel responses. The motion to compel responses is moot and the discovery motion was not timely filed. If the board considers the motion to compel, the board should consider only the relevant interrogatories and request for production of documents.

MOTION IS MOOT

The discovery motion is moot because the motion for summary judgment should dispose of the case in favor of the opposer. Regarding the state of the discovery, opposer had no need to propound discovery, because opposer has all documents necessary to prove that the mark is functional. Almost all of the documents are public domain documents and have been presented to the applicant. The functionality of the mark is so obvious that the motion for summary judgment should be granted making moot the need to review and wade through this motion to compel.

The functionality of the mark is seen in the patents that are cited. These patents should be accorded great weight in deciding functionality of the trademark. The test for functionality of

a trademark is not a checklist, and great weight should be accorded to the patent disclosures because they specifically disclose the functional and utilitarian advantages of applicant's claimed trademark. Therefore, this motion should be decided after the motion for summary judgment, because it is very likely that the motion for summary judgment is dispositive in this case.

The main arguments are that the applicant wants evidence of opposer sales. The applicant also wants evidence that alternate bottles cost more or less to make. A mark can be functional because it has utilitarian advantages, or because it is cheaper and easier to make. In this case, opposer highlights the functional advantages, and the applicant has not responded to the arguments regarding functional advantages.

Applicant argues that evidence of opposer sales and costs are key to this case, which it is not. Evidence regarding quantity of opposer sales is not relevant when the trademark is functional. Because the trademark is functional, a perpetual patent granted by the trademark office would oppress the opposer. Even if opposer had no sales, such patent like rights would be extremely impressive to the opposer. Therefore, the opposer would have standing whether or not the opposer had sold any units at all. Opposer's sales and costs would not change the fact that the Trademark Office has no business granting patents.

MOTION IS NOT TIMELY FILED

The discovery motion was not timely filed. The motion was not filed before the opening of the first testimony period. 37 CFR 2.120(e) requires in pertinent part that, "The motion must be filed prior to the commencement of the first testimony period as originally set or as reset." The plaintiff testimony period was first set to end on April 27, 2006. Therefore, the opening period was March 28, 2006 because there are 31 days in March. On April 6, 2006, opposer served a notice of deposition on the applicant. Applicant served opposer and filed a motion to

compel on April 10, 2006. The current opposer testimony period that began April 27, 2006 became suspended, and will end 30 days after the board rules on the motions. Therefore, the motion was not filed prior to the commencement of the first testimony period as originally set or as reset. After the first testimony period commenced, the language of 37 CFR 2.120(e) clearly cuts off the right to file discovery motions. Even if commencement of a testimony period does not cut off the right to file motions to compel, the beginning of discovery activity such as serving a notice of deposition cuts off the right to file discovery motions.[1]

Opposer served responses to the discovery requests on February 28, 2006. Applicant did not comment regarding the sufficiency of the responses, and then applicant attorney sent a letter on March 27th, 2006 demanding supplemental responses by March 29, 2006 to all interrogatories except for 2, 10 and 34. Because the March 27th letter was sent later in the day, the attorneys discussed the substance of the specific alleged insufficiency of the discovery responses on March 28th, 2006. Opposer served a notice of deposition on the applicant.

Applicant attempted to file the motion on March 29, 2006, but did not. The motion was not filed on March 29, 2006. The applicant attorney claims to have served opposer the motion to compel and motion for protective order in a Federal Express package of March 29, 2006, however, the tracking number 813368675994 is a bad tracking number. Anyone can verify this by going to the www.fedex.com website and entering in the tracking number. Additionally, the zip code for the opposer attorney is wrong (92708 correct, 92703 wrong) and consequently the opposer attorney could not have possibly received the motion to compel and motion for protective order. Because a proper proof of service is required, this lack of proper service

[1] *See* 37 CFR § 2.120(e); and, *for example*, *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v.Colli Spolentini Spoletoducale SCRL,* 59 USPQ2d 1383, 1383 (TTAB 2001) (untimely motion to compel denied).

address presents a technical defect in the motion. In any case, this was cleared up on April 10, 2006 with a second fedex copy from applicant. However, April 10, 2006 is after applicant received opposer notice of deposition during the opposer testimony period.

The filing of the motion to compel, and the motion for summary judgment suspended the proceedings. The parties submitted a stipulation to this effect, but the stipulation does not waive 37 CFR 2.120(e).

MOTION ASKS FOR IRRELEVANT EVIDENCE

Furthermore, the motion is moot because the opposer has inherent motivation to provide supplemental responses, and will. Opposer will be providing supplemental responses, not out of fear of sanctions, but rather to bolster its case.

Usually, a motion to compel outlines each alleged insufficiency in each interrogatory and request for production, which applicant does not. If the responses were itemized, the board could easily sort out and rule on the relevant interrogatories as opposed to the irrelevant ones. Because they are all lumped together, it requires a reader to go through the entire requests and response and make a presumption regarding what the applicant arguments would be regarding each response. The vagueness of the allegations makes it difficult to respond to the arguments raised in the motion to compel.

Some interrogatories are relevant and some are not. An example of a relevant interrogatory is the first interrogatory. The first interrogatory, was initially impossible to answer because the applicant had never seen a high-resolution photograph of the older Triforest bottle so they were unable to confirm that the high resolution image actually infringed. The opposer took high-resolution photographs and sent them to the applicant. In subsequent discussions between the attorneys, as seen in the attached correspondence to the motion to compel, the attorneys

established what the applicant considered to be infringing. This is a key issue and opposer will provide a detailed response to the first interrogatory.

Other interrogatories are entirely irrelevant. An example of an irrelevant interrogatory is the fourth interrogatory because it asks for information that the applicant already has and that could not possibly make any difference in the outcome of this case. The location of the street address would not make it more or less probable that the mark is functional.

CONCLUSION

In conclusion, the functional nature of the trademark should be readily apparent. The Trademark Trial and Appeal Board should review the prosecution history that will show no arguments regarding functionality or secondary meaning.

Respectfully submitted,

By Clement Cheng, Esq. _____ Date: 4/25/2006
17220 Newhope St., Suite 127
Fountain Valley, CA 92708

PROOF OF SERVICE

In the matter of trademark application Serial No. **76/572,253**

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On APRIL 24TH, 2006, I served:

REPLY TO MOTION TO COMPEL

By express mail, placing true copies thereof in a sealed envelope, addressed as follows to:

1 copy sent to:
DONALD F. FREI
WOOD, HERRON & EVANS, L.L.P.
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202-2917
ATTORNEY FOR APPLICANT

1 copy sent to:
Mail Stop TTAB
Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

☐ BY PERSONAL SERVICE: I caused such envelope to be delivered by hand to the offices of the addressee(s).

☒ BY MAIL: I am readily familiar with the practice of the office for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, correspondence is put in the office outgoing mail tray for collection and is deposited in the U.S. Mail that same day in the ordinary course of business. I am aware that, on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.

☒ FEDERAL: I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

☐ STATE: I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed on APRIL 24TH, 2006, at Fountain Valley, California.

signer

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